

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-21 are pending in the application, with claim 1 being the independent claim.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned “**Version with markings to show changes made.**”

Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Allowed Subject Matter

The indication that claims 4-7, 11 and 16-18 contain allowable subject matter is gratefully noted.

Rejections under 35 U.S.C. § 112

Claims 1-15, 19 and 20 stand rejected under 35 U.S.C. §112, first paragraph, for lack of enablement. Specifically, the Action alleges that, although the specification is enabling for a channel with three walls, it does not reasonably provide enablement for a channel formed by two walls. The Action further states that, as recited in claim 1, the channel may be formed from two walls, four walls or an infinite number of walls. Reconsideration is respectfully requested.

It is respectfully submitted that the Applicants are not required by Section 112 to recite a specific number of walls. The Examiner is correct in stating that claim 1 allows the channel to be formed from any number of walls. However, this fact should not result in a rejection for lack of enablement.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Teletronics, Inc.*, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) As long as the specification discloses at least one method of making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 166 USPQ 18, 24 (CCPA 1970); see also, MPEP §2164.01(b). It is respectfully submitted that the disclosure explicitly discloses at least one method of making and using the invention, namely, a channel with three walls. Furthermore, it is respectfully submitted that it would be well within the purview of one skilled in the art to make a channel with more or less walls. For example, it can be envisioned that the channel could be made with two walls intersecting at an apex. In this example, the channel would appear to be an inverted “V” in cross section. Alternately, the channel could have five walls and would appear as half an octagon in cross section. Although the channel explicitly described in the application is the preferred embodiment, one skilled in the art could easily make channels with more or less walls, and the Applicant should not be limited to a specific number of walls. Accordingly, withdrawal of the enablement rejection is respectfully requested.

Claims 4-7 are rejected under 35 U.S.C. §112, second paragraph, as being “incomplete for omitting essential structural cooperative relationships of elements.” It is respectfully submitted that the specification does not describe either the endless flexible element or toothed belt recited in claims 4-7 as “essential”, which is required for a rejection under this provision. See MPEP §2172.01. The scope of the invention broadly claimed in claim 1 is only limited to “elongated walls” and their equivalents. However, without conceding to the appropriateness of the rejection, but to advance prosecution, Applicant has amended claim 4 to provide a structural relationship for the toothed belt and flexible element.

Rejections under 35 U.S.C. § 102

Claims 1-3, 9, 10, 12, 13, 19 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Garthaffner et al. (US 4,817,638) (“Garthaffner”). Reconsideration is respectfully requested.

Claim 1 recites that the apparatus transports a “stream of particulate material.” Many of the claimed features are specifically limited to transporting such a stream of particulate material. For example, claim 1 recites that the elongated walls define a “stream-receiving and guiding path” and that at least one of the walls has a “stream-contacting surface provided with material-receiving recesses.” In contrast to transporting the stream of particulate material, Garthaffner teaches an apparatus for transporting a fully formed cigarette. The differences between

particulate material and a formed cigarette are significant, and the apparatus in Garthaffner is clearly not suitable for transporting particulate material.

Accordingly, it is respectfully submitted that claim 1 distinguishes over Garthaffner and is allowable over Garthaffner. Claim 2, 3, 9, 10, 12, 13, 19 and 20 are ultimately dependent from claim 1 and are allowable as being dependent from an allowable claim.

Other dependent claims further distinguish over Garthaffner.

Claim 9 has been amended to specify that at least two of the walls are movable lengthwise relative to the channel. Because the cigarettes in Garthaffner are transported perpendicular to the length of the “channel” formed between conveyors 23 and 21, neither of the conveyors move lengthwise relative to the channel.

Claim 13 recites that the path has a decreasing width. The Action states that the recesses 21 of Garthaffner decrease in width. Even if this were true, it is respectfully submitted that the width of the path does not decrease. Furthermore, after a careful review of Garthaffner, it is not believed that Garthaffner teaches that the recesses decrease in width. The widths of the recesses 21 appear to be constant over the circumference of drum 22.

Claim 20 recites that the apparatus further comprises “means for showering particulate material.” It is respectfully submitted that Garthaffner does not “shower” material into the path of the conveyor 21 and particularly does not shower “particulate material”.

Claims 1-3, 9, 10 and 20 are rejected under 35 U.S.C. §102(e) as being anticipated by Dombek (U.S. 6,390,099). The rejection based on Dombek has the same deficiencies as the rejection based on Garthaffner, discussed above. Specifically, Dombek transports completed cigarettes, not particulate matter. Accordingly, it is respectfully submitted that claim 1 distinguishes over Dombek and is allowable over Dombek

Claims 2, 3, 9, 10 and 20 are dependent from claim 1 and are allowable as being dependent from an allowable claim. Moreover, similar to the rejection based on Garthaffner, Dombek fails to teach the features particularly recited by claims 9 and 13.

Rejections under 35 U.S.C. § 103

Claims 8, 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Garthaffner. Claims 8, 14 and 15 are dependent from claim 1. Garthaffner fails to suggest the features of claims 8, 14 and 15. Accordingly, it is respectfully submitted that claims 8, 14 and 15 are allowable as being dependent from an allowable claim.

Claim 15 further distinguishes over Garthaffner. Claim 15 recites that the stream is convertible into rod-like fillers having a predetermined length and that the material-receiving recesses are spaced apart from each other lengthwise of said at least one wall by a whole multiple of said predetermined length. Concerning this feature, the Action states “the distance between each recess is a multiple of the path of formed by Garthaffner’s conveying channel.” It is assumed that this rejection is inadvertently incomplete. First, the Action does not state how

Garthaffner teaches the claimed features. The Action states that the recess is a multiple of the path. The claim recites that the recess is a multiple on the length of the filler. Also, the Action does not state how Garthaffner is deficient with respect to this claimed feature and why one would be motivated to modify Garthaffner to meet the claimed feature, as required for an obviousness rejection. In any event, it is respectfully submitted that Garthaffner fails to teach or suggest claim 15.

New Claims

Claim 21 has been added and recites that at least one of the walls is movable lengthwise relative to the channel. Dombek and Garthaffner each teach that the conveyors move in a direction which is perpendicular to the channel. Accordingly, it is respectfully submitted that claim 21 is allowable over the cited prior art.

Applicants: Clemens Schmick et al.
Appl. No. 09/785,508

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance with claims 1-21.

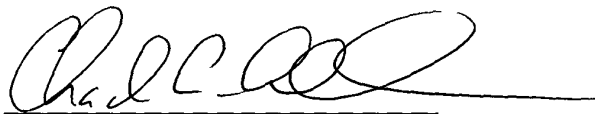
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

Date: _____

09/04/02



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Version With Markings To Show Changes Made

In the Claims:

Please amend claims 4 and 9, and add new claim 21.

4. (Amended) The apparatus of claim 3, wherein said endless flexible element is
[includes] a toothed belt.

9. (Amended) The apparatus of claim 1, wherein at least two of said walls are movable
lengthwise relative to the channel.

21. (New) The apparatus of claim 1, wherein the at least one wall is movable lengthwise
relative to the channel.

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